

National Stage Commencement and Entry in the United States of America

by

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Commencement of the National Stage:

Commencement of the national stage in the United States of America occurs with the expiration of the applicable time limit set forth under Article 22(1) or (2), or under Article 39(1)(a), of the Patent Cooperation Treaty (PCT) as set out in 35 U.S.C. 371(b).

The applicable time limit set forth under PCT Article 22(1) and (2) is 20 months from the priority date. Where no claim for priority was made, the time limit is 20 months from the international filing date.

The applicable time limit set forth under PCT Article 39(1) is 30 months from the priority date. Where no claim for priority was made, the time limit is 30 months from the international filing date.

Stated differently, commencement of the national stage in the United States of America occurs at the expiration of 20 or 30 months from the priority date. Where no claim for priority was made, commencement of the national stage occurs at the expiration of 20 or 30 months from the international filing date.

Entry into the National Stage:

Entry into the national stage in the United States of America occurs when an applicant has filed all of the documents and fees required by 35 U.S.C. 371(c) within the time periods set forth in 37 CFR 1.494 or 1.495.

If the United States of America is a designated State and a proper DEMAND (Form PCT/IPEA/401) for international preliminary examination electing the United States of America **was not** filed prior to the expiration of 19 months from the priority date (or 19 months from the international filing date where no claim for priority was made), the time periods set forth under 37 CFR 1.494 are applicable (20 month time period).

If the United States of America is an elected State, i.e., a proper

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DEMAND for international preliminary examination electing the United States of America was filed prior to the expiration of 19 months from the priority date (or 19 months from the international filing date where no claim for priority was made), the time periods set forth in 37 CFR 1.495 are applicable (30 month time period).

The five (5) requirements for national stage entry under 35 U.S.C. 371(c) are:

- (1) payment of the requisite basic national fee (see 35 U.S.C. §§ 376 and 41(a) and 37 CFR 1.492);
- (2) a copy of the international application and an English language translation of the international application if the international application was filed in another language;
- (3) amendments, if any, to the claims made under PCT Article 19 in response to an International Search Report and an English language translation of the PCT Article 19 amendments if the amendments were made in another language;
- (4) an oath or declaration of the inventor(s) complying with the requirements of 35 U.S.C. 115 and with the regulations prescribed for oaths or declarations of applicants (37 CFR 1.497); and,
- (5) an English language translation of any annex to the International Preliminary Examination Report (Form PCT/IPEA/409) if the annex was made in another language.

Submissions Required Prior to the Expiration of 20 or 30 Months.

Payment of the requisite basic national fee (35 U.S.C. 371(c)(1)) and a copy of the international application (35 U.S.C. 371(c)(2)) **MUST** be submitted prior to the expiration of 20 or 30 months (37 CFR 1.494(b) or 37 CFR 1.495(b)).

Pursuant to PCT Article 20 and PCT Rule 47, a copy of the international application is communicated by the International Bureau to each designated Office, except for any Office that has waived the requirement that the communication be made thereto. Communication of the international application to each applicable designated State, including the United States of America, typically occurs promptly after International Publication at 18 months from the priority date or international filing date but must be effected prior to

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the expiration of 19 months from the priority date or international filing date. The copy of the international application communicated to the United States Patent and Trademark Office satisfies applicant's 35 U.S.C. 371(c)(1) requirement for a copy of the international application as filed.

The International Bureau informs applicants to which designated Offices the communication pursuant to PCT Article 20 and PCT Rule 47 has occurred and the date on which it occurred. This notice is accepted by the United States Patent and Trademark Office as conclusive evidence that the communication has occurred. Receipt of this notice, i.e., the PCT/IB/308 informs applicant that the requirement for submitting a copy of the international application under 35 U.S.C. 371(c)(1) has been satisfied.

If the international application was originally filed with the United States Patent and Trademark Office as receiving Office, there is no need to file an additional copy of the international application for national stage entry (see 37 CFR 1.494(b)(1) or 37 CFR 1.495(b)(1)). The United States Designated/Elected Office will, upon receipt of applicants first submission for national stage entry, make a copy of the international application (i.e., description, claims, drawings, and abstract) for use in the national stage application. If, however, applicant files a copy of the international application, applicant's copy will be used as long as applicant's copy is identical to the international application as originally filed.

The 20 or 30 month time limit for submitting the requisite basic national fee and the copy of the international application **MAY NOT BE EXTENDED**.

If the requisite basic national fee and the copy of the international application are not filed prior to the expiration of 20 or 30 months, the international application becomes **ABANDONED** with respect to the United States of America pursuant to 37 CFR 1.494(g) or 37 CFR 1.495(h).

If the requisite basic national fee and the copy of the international application are submitted prior to the expiration of 20 or 30 months but either: (1) a translation of the international application; and/or, (2) an acceptable oath or declaration of the inventor(s) has not been filed, applicant will be notified by the United States Designated/Elected Office and given a time period within which to file the translation and/or the oath or declaration. If the translation and/or the oath or declaration are not received within the time period set forth in the notice, the international application will become **ABANDONED** with respect to the United States of America pursuant to 37 CFR 1.494(g), or 37 CFR 1.495(h). The time period set forth in the notice is extendable under 37 CFR 1.136(a).

If an international application becomes abandoned with respect to the United States

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of America for failure to timely comply with any of the requirements for national stage entry under 35 U.S.C. 371(c), the provisions of 37 CFR 1.137(a) and (b) for revival of the application are available.

English Translation of the International Application:

The English language translation of the international application is required to be a translation of the international application as filed with any changes which were properly accepted by the receiving Office under PCT Rule 26 and/or any rectifications which were properly accepted by the International Searching Authority under PCT Rule 91. In other words, applicant should file a translation of the international application as filed.

Amendments, even those considered to be minor or not to include new matter, may not be incorporated into the translation. If an amendment to the international application as filed is desired for national stage in the United States of America, it should be submitted as a preliminary amendment in accordance with 37 CFR 1.121 and should accompany the initial national stage submission or, at the latest, be submitted within 1 month after completion of the requirements under 35 U.S.C. 371 for entry into the national stage.

If the basic national fee has been timely submitted, i.e., submitted prior to the expiration of 20 or 30 months, but the translation of the international application is missing or is defective, a notice of Missing Requirements will be issued setting forth a time period in which to file a translation or a corrected translation. The time period set forth in the notice will be one month from the mailing date of the notice or the expiration of 21 or 31 months, whichever is later. The time period may be extended pursuant to the provisions of 37 CFR 1.136(a).

If a translation of the international application, i.e., an acceptable translation, is filed after the expiration of 20 or 30 months, payment of a processing fee, pursuant to 37 CFR 1.492(f), is required.

Amendments Under PCT Article 19 for National Stage Entry:

A PCT Article 19 amendment is an amendment made to the claims of an international application in response to an International Search Report and submitted, within the time period set forth in the International Search Report, directly to the International Bureau. These amendments, when made, are forwarded by the International Bureau to each State designated

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in the international application for purposes of the national stage.

In the United States of America, entry of a timely received PCT Article 19 amendment in the national stage application is automatic unless: (1) the amendment is in a language other than English; or, (2) applicant expressly requests that the amendment not be entered.

If a PCT Article 19 amendment received from the International Bureau is not in the English language, the amendment will not be entered unless applicant has provided an English language translation of the PCT Article 19 amendment prior to the expiration of 20 or 30 months from the priority date or, if applicable, the international filing date. If an English language translation of the PCT Article 19 amendment is not received prior to the expiration of 20 or 30 months, the amendment will be considered to be cancelled as set forth in 35 U.S.C. 371(d) and will not be entered. The 20 or 30 month time limit may not be extended.

Entry of a PCT Article 19 amendment or an English translation thereof will be effected by substituting each page of the amendment or translation with each corresponding page of claims of the national stage application.

If entry of a page of the translation causes inconsistencies in the claims of the national stage application, the translation will not be entered.

As an alternative, applicant may, if desired, submit a preliminary amendment to the claims in accordance with 37 CFR 1.121 and dispense with entry of a PCT Article 19 amendment or English language translation thereof.

Oath or Declaration of the Inventor(s):

In order for an oath or declaration of the inventor(s) to be acceptable for national stage entry, i.e., to satisfy the requirement of 35 U.S.C. 371(c)(4), the oath or declaration **MUST** be in compliance with 35 U.S.C. 115 and 37 CFR 1.497.

If the basic national fee has been timely submitted, i.e., prior to the expiration of 20 or 30 months, but the required oath or declaration of the inventor(s) has not been filed or is defective, a notice of Missing Requirements will be issued setting forth a time period in which to file an oath or declaration or a corrected oath or declaration. The time period set forth in the notice will be one month from the mailing date of the notice or the expiration of 21 or 31 months, whichever is later. The time period may be extended pursuant to the provisions of 37 CFR 1.136(a).

If an oath or declaration, i.e., an acceptable oath or declaration, is filed after

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the expiration of 20 or 30 months, payment of a surcharge, pursuant to 37 CFR 1.492(e), is required.

If an inventor refuses to execute the oath or declaration or is unavailable, an oath or declaration must be submitted in accordance with the provisions of 37 CFR 1.47.

If an inventor is deceased or legally incapacitated, an oath or declaration in accordance with the provisions of 37 CFR 1.42 or 1.43 must be submitted. If an oath or declaration is filed under 37 CFR 1.42 and proof of authority of the legal representative as required by 37 CFR 1.44 has not been provided, the application papers will be provisionally accepted for entry into the national stage and forwarded for further processing and examination on the merits. If sufficient proof of authority of the person(s) signing as legal representative on behalf of the deceased inventor has not been provided before mailing of a notice of allowance, the application will be forwarded to the PCT Legal Affairs Division from the Patent Examiner in charge of the national stage application. If proof of authority is not filed, the application will be held not to have entered the national stage for failure to provide an oath or declaration as required under 35 U.S.C. 371(c)(4) and the application will be held **ABANDONED** pursuant to the provisions of 37 CFR 1.494(g) or 1.495(h). The date of abandonment will be the expiration date of 20 or 30 months or, where a notification of deficiency of the oath/declaration has been mailed, the date of expiration of the time for response to that notification or as extended under the provisions of 37 CFR 1.136(a).

In order to avoid **ABANDONMENT** of an international application in the United States of America in a situation where status under 37 CFR 1.42, 1.43, and/or 1.47 is needed, an oath or declaration and a petition requesting such status must be filed either before the expiration of 20 or 30 months or, where a Notification of Missing Requirements has been mailed, within the time period for response set forth in the Notification.

Annexes to the International Preliminary Examination Report for National Stage Entry:

An annex to the International Preliminary Examination Report is a PCT Article 34 amendment to the description, claims, and/or drawings of an international application filed during international preliminary examination. After establishment of the International Preliminary Examination Report, the International Searching Authority forwards the International Preliminary Examination Report and any annex, filed by applicant, to the International Bureau. The International Bureau will, in turn, forward a copy of the International Preliminary Examination Report and the annex to each eligible national or regional Office elected in the DEMAND for purposes of the national stage

In the United States of America, entry of an annex to the International Preliminary Examination Report in the national stage application is automatic unless:

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(1) the annex is in a language other than English; or, (2) applicant expressly requests that the annex not be entered.

If an annex to the International Preliminary Examination Report received from the International Bureau is not in the English language, the annex will not be entered unless applicant has provided an English language translation of the annex.

Entry of an annex to the International Preliminary Examination Report or the English translation thereof will be effected by substituting each page of the annex or translation with the corresponding page of description, claims, and/or drawings of the international application.

If entry of a page of the translation of an annex causes inconsistencies in the description, claims and/or drawings of the international application, the translation of the annex will not be entered.

An English translations of an annex to the International Preliminary Examination Report which is not timely received will be considered to be cancelled and will not be entered. A translation of an annex which is not received by the expiration of 30 months from the priority date or international filing date may be submitted within any period set pursuant to 37 CFR 1.495(c) accompanied by the processing fee set forth in 37 CFR 1.492(f). The 30 month time period may not be extended.

As an Alternative, an applicant may, if desired, submit a preliminary amendment to the description, claims, and/or drawings of the national stage application accordance with 37 CFR 1.121 and dispense with entry of an annex to the International Preliminary Examination Report.

The Filing Date of a National Stage Application:

Pursuant to PCT Article 11(4) and 35 U.S.C. 363, the filing date of a national stage application in the United States of America is the international filing date, i.e., the filing date of the international application. The international filing date is the critical date for determining whether or not a particular reference is available as prior art against the subject matter of a national stage application.

35 U.S.C. 102(e) Date:

The 35 U.S.C. 102(e) date is the date on which the requirements of 35 U.S.C. 371(c)(1), (2), and (4) are completed. In other words, the 35 U.S.C. 102(e) date is the date

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on which an applicant completes the filing of: (1) the requisite basic national fee; (2) a copy of the international application with any necessary English language translation; and, (3) an acceptable oath or declaration of the inventor(s).

The 35 U.S.C. 102(e) date is an important date for a patent which issues from a national stage application. Although the 35 U.S.C. 102(e) date is not an effective date during the pendency of the national stage application, the 35 U.S.C. 102(e) date is the earliest date on which a United States Patent, which issued from a national stage application, can effectively be used as "prior art" against a pending United States patent application. An applicant may establish a 35 U.S.C. 102(e) date by satisfying the requirements of 35 U.S.C. 371(c)(1), (2), and (4) anytime prior to the expiration of 20 or 30 months from the priority date or international filing date.

35 U.S.C. 371 Date:

The 35 U.S.C. 371 date is the date on which all of the requirements for national stage entry in the United States of America under 35 U.S.C. 371(c)(1), (2), (3), (4), and (5) have been completed. In other words, the 35 U.S.C. 371 date will be the date applicant has filed: (1) the requisite basic national fee; (2) a copy of the international application and any necessary English language translation; (3) a copy of amendments unless provided by the International Bureau, if any, to the claims made under PCT Article 19 in response to an International Search Report and any necessary English language translation of the PCT Article 19 amendments; (4) an acceptable oath or declaration of the inventor(s); and, (5) an English language translation of any annexes to the International Preliminary Examination Report, if any, if the annex was made in another language.

Filing Receipt for National Stage Applications:

The actual filing date of a national stage application in the United States of America, and all other PCT Contracting States, is the international filing date (see "The Filing Date of a National Stage Application" section above). The date which appears in the filing date box of the Filing Receipt, however, is the 35 U.S.C. 371 date (see "35 U.S.C. 371 Date" section above) which is typically not the same as the international filing date. The international filing date, i.e., the actual filing date for purposes of applying prior art to the national stage application, will appear on the Filing Receipt next to the international application number in the "CONTINUING DATA" section.